UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,193	03/10/2000	Sean Matthew Doherty	169.1649	4782

5514 7590 06/03/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
YOUNG, JOHN L

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.	Applicant(s)
09/523,193	Doherty
Examiner	**Art Unit**
John Young	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED *May 12, 2003* FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see NOTE below);

(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: *See attached.*

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: *1-28*

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other:

5-30-03

ADVISORY AFTER FINAL AMENDMENT CONSIDERED (NOT ENTERED)

(PAPER # 14)

1. **The AFTER FINAL AMENDMENT C (filled 05/12/03 as paper#13, not entered) has been considered but does not overcome the rejections of claims 1-28.**

It is well settled by rule that "[on] the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants . . . patent owner's reply is limited to appeal in the case of rejection of any claim . . . or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim. . . ." (See 37 CFR § 1.113).

It is also well settled by rule that "[after] a final rejection or other final action . . . in an application . . . amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission or refusal to admit, any amendment after a final rejection . . . will not operate to relieve the application . . . from its condition as subject to appeal or to save the application from abandonment. . . . If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented." (See

37 CFR § 1.116).

EXAMINER'S RESPONSE TO ARGUMENTS

2. Applicant's arguments (paper#13, filed 05/12/03) have been fully considered but they are not entered and are not persuasive for the following reasons:

In response to Applicant's argument (paper#13, pp. 14-20) which asserts that "this After Final Rejection[sic] clearly places the subject application in condition for allowance. This Amendment was not earlier presented because Applicant believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of the instant Amendment as an earnest attempt to advance prosecution and reduce the number of issues is requested under 37 CFR §1.116. . . .", **in this case, no amendments are "made canceling claims or complying with any requirement of form expressly set forth in a previous office action. . . . [or] presenting rejected claims in better form for consideration on appeal. . . ." And, not withstanding Applicant's assertion that "Applicant believed that the prior Amendment placed the subject application in condition for allowance. . . ." there is no showing of good and sufficient reasons why Amendment C was not earlier presented. THEREFORE, Amendment C after final is not admitted.**

As per independent claims 1, 25 & 27, Applicant's arguments (paper#13, pp. 15-16; and p. 17, ll. 1-6) assert that "Dimitriadis, et al., contains no disclosure or suggestion

of. . . ." the features recited in said claims. This is not the case.

It is well settled that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, and throughout the prior office actions and in the rejections supra the Examiner has relied upon the knowledge generally available to one of ordinary skill in the art and the Examiner has detailed with particularity where the features of claims 1, 25 & 27 are suggested in the prior art reference and where there is some teaching in the reference to modify the reference to derive the present invention.

As per independent claims 14, 26 & 28, Applicant's arguments (paper#13, pp. 17-19) assert that "Dimitriadis, et al., contains no disclosure or suggestion of. . . ." the features recited in said claims. This is not the case.

It is well settled that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d

347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, and throughout the prior office actions and in the rejections supra the Examiner has relied upon the knowledge generally available to one of ordinary skill in the art and the Examiner has detailed with particularity where the features of claims 14, 26 & 28 are suggested in the prior art reference and where there is some teaching in the reference to modify the reference to derive the present invention.

Applicant's argument (paper#13, pp. 19-20) which asserts that the dependent claims in the instant application are allowable because they depend from allowable independent claims amounts to a general allegation that the dependent claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

FINAL ACTION MAINTAINED

The shortened statutory period for reply expires three months from the mailing date of the final rejection. However, in no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

CONCLUSION

3. Any response to this action should be mailed to:

Box AF

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Patent Examiner

May 30, 2003